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10/566,271	09/27/2006	Masayoshi Son	285305US2X PCT	1694
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER OVANDO, PABLO R	
			ART UNIT	PAPER NUMBER
			2614	
			NOTIFICATION DATE	DELIVERY MODE
			02/08/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/566,271

Applicant(s)

SON, MASAYOSHI

Examiner

Pablo R. Ovando

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: Page 15, line 35 refers to "telephone terminal 31", based on the drawings, it should refer to "telephone terminal 21".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

**Claims 1, 9, 12 and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 4-7 are not understood. Specifically, "connect a call at a predetermined telephone number to said terminal device"; what is the relationship between the terminal device and the predetermined telephone number? Also, how is the designation address **associated** with the predetermined telephone number? Claim 1, line 10, how is the network related to the other components? What is the designation address? Claim 1, lines 27, 33, 37 recite three instances of "priority registration Address". Which priority registration address is set as the basis and what is the correlation?

Claims 9, 12 and 18 are vague and indefinite for the same reasons as mentioned in claim 1, since the claims encompass the same subject matter.

Claim 20, line 7 recites "call connection server receives said user identifier and said password from said call connection server", how is the call connection server receiving information from the call connection server? Should it be receiving the information from the terminal device?

### ***Claim Objections***

As to claims **8 and 17**, the word "removably" is not in the English dictionary.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon Lee et al, US Patent 6,958,992 (hereinafter referenced as Gordon) in view of Hee Lee et al, US Patent 6,751,459 (hereinafter referenced as Hee).

As to **claim 1**, Gordon teaches a terminal device comprising: a registration information transmitting unit operable to transmit (col. 3, lines 26-32 and 45-50 teach that the IP phone 102 communicates with an IP phone switch 100, which necessarily

indicates that there is a transmitting unit since information is transmitted between both devices) , when connecting with a network (fig. 1, LAN 104) which can be used for communication with said call connection server, to said call connection server (IP phone switch 100) a terminal identifier for identifying said terminal device (Col. 2 lines 26-28, "Media access control") and a terminal location address (col. 1, lines 25-30 teach that a phone has an IP address to indicate the network where it is located. col. 2, lines 27-36 teach the well known concept of DHCP which reinstates that the network knows the location of the user through the IP address) for identifying the location thereof on said network with which said terminal device is connected,

said call connection server comprising: a storing unit operable to store said designation address and said terminal identifier in association with said predetermined telephone number (col. 3 lines 47-60, note that the DN will be associated with the MAC address. Thus proper routing will be conducted. Additionally the subscriber's user name is provided); a registration information receiving unit operable to receive said terminal identifier and said terminal location address (col. 3 lines 26-32); an authentication unit operable to authenticate said terminal device on the basis of said terminal identifier which is received and said terminal identifier which is stored in said storing unit (col. 3, lines 33-36, "checks the information against its look up table");

However, Gordon does not explicitly teach a priority designation address setting unit set said terminal location address as a priority designation address which is given a priority higher than said designation address; and a call connection unit operable to connect

said call to said terminal device on the basis of said terminal location address in the case where said priority designation address has been set up.

In the same field of endeavor, Lee teaches a PMDS server that keeps track of where in the network the user has registered (col. 2 lines 61-67). Additionally, Lee teaches a profile with a variety of TID in fig. 4, element 208. Col. 6, lines 30-46 teach that dynamic data is provided to select the most current terminal and the user might be contacted at the terminal device where the user is most likely to be present) ; and a call connection unit operable to connect said call to said terminal device on the basis of said terminal location address in the case where said priority designation address has been set up (col. 6, lines 40-45 and col. 8, lines 4-8). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply the teachings of Hee in Gordon for the purpose of providing nomadic user a way of receiving calls at any location.

As to **claim 2**, Hee teaches a call connection server further comprises a detection unit operable to detect that said terminal device is disconnected from said network (PMDNS server 208 is able to detect if the terminal is connected. Thus, it necessarily has a detection unit) , and wherein when said detection unit detects that said terminal device is disconnected from said network, said priority designation address setting unit deregisters said priority designation address as set (col. 8 lines 53-59, teach that the server detects when the user has de-registered).

As to **claim 3**, Gordon teaches that the storing unit is operable to further store, in association with said predetermined telephone number, a user identifier for identifying a user who utilizes said predetermined telephone number and a password associated with said user identifier (col. 3, lines 35-59); wherein said registration information transmitting unit is operable to further transmit said user identifier and said password to said call connection server (col. 3, lines 35-59); wherein said registration information receiving unit is operable to receive said user identifier and said password (col. 3, lines 35-59); and wherein said authentication unit is operable to authenticate said terminal device on the basis of said terminal identifier, said user identifier and said password as received.

**As to claim 4**, Gordon teaches that the terminal device further comprising a terminal identifier storing unit operable to store said terminal identifier in order that said terminal identifier can be read only by said registration information transmitting unit; and wherein said registration information transmitting unit is operable to transmit said terminal identifier as read from said terminal identifier storing unit to said call connection server (col. 2, lines 27-30).

**As to claim 5**, Gordon in view of Hee do not explicitly teach that a terminal device comprises a user information storing unit operable to store said user identifier and said password; and wherein said registration information transmitting unit is operable to transmit said terminal identifier and said user identifier and password stored in said user information storing unit to said call connection server the combination

above teaches that the user enters a user name and a password. However, examiner takes Official Notice that storing information on a storing unit is notoriously well known in the art. The motivation for storing would be for saving the user the hassle of having to enter the information more than once.

As to **claim 6**, Hee teaches that a terminal device includes: a private base station apparatus that can be connected with said network (fig. 1 element 130); and a mobile terminal device (fig. 1 element 132) provided with said registration information transmitting unit and connectable with said network by wireless communication (fig. 1 element 112) through either a public wireless base station (fig. 1 element 130) or said private base station apparatus, and wherein said mobile terminal device can perform wireless communication with said private base station apparatus by the use of the same protocol as it uses for the wireless communication with said public wireless base station (fig. 1 element 114).

As to **claim 7**, Hee teaches that each of said mobile terminal device (element 132) and said private base station apparatus (element 130) is provided with: a first communication interface operable on the basis of said protocol (both elements connect wirelessly, i.e., CDMA); a second communication interface operable for local communication (IP network 102, the connection between G/W and IP network 102); and a switch unit operable to switch between said first communication interface and said second communication interface in accordance with the manipulation of a user (PDMS server 150).



As to **claim 8**, Hee teaches an antenna in the mobile terminal device 132. However, Gordon in view of Hee do not explicitly teach an adapter unit which is removably attached to a computer. Examiner takes Official notice that adaptors are notoriously well known in the art. The motivation for having an adaptor would be for the user to efficiently engage in wireless communications.

As to **claim 9**, see rejection of claim 1.

As to **claims 10 and 11**, see rejection of claim 2 and 3 respectively.

As to **claim 12**, see rejection of claim 1.

As to **claims 13-17**, see similar rejection to 4-8 respectively.

As to **claim 18**, see rejection of claim 1.

As to **claims 19-23**, see rejection of claims 2-6 respectively

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo R. Ovando whose telephone number is 571-272-9752. The examiner can normally be reached on M-F 7:30 am to 5:00pm, EST, Alternating Fridays off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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P.O.

  
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